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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,086	01/17/2006	Bandi Parthasaradhi Reddy	H1089/20029	6020

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CAESAR, RIVISE, BERNSTEIN,  
COHEN & POKOTILOW, LTD.  
11TH FLOOR, SEVEN PENN CENTER  
1635 MARKET STREET  
PHILADELPHIA, PA 19103-2212

EXAMINER
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BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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09/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,086	<b>Applicant(s)</b> PARTHASARADHI REDDY ET AL.	
	<b>Examiner</b> Mark L. Berch	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/13/2009 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-35, 37-40, 42-45, 47-48, 50-51, 53-58, 60-62, 64-66, 68-72, 74-75, 77-78, 80-81, 83-84, 86-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The (OCO)<sub>n</sub> structural piece is ambiguous. Is the O bound to the Si on the left or the N on the right? As stated in *In re Zletz*, 13 USPQ2d 1320, 1322, "An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous." For whichever choice is selected, applicants must show that one skilled in the art could have figured out that this choice, and not another, was surely intended.

The traverse is unpersuasive. The quotation from *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 is not apt. That was from a discussion of standards applying after claims have been issued. As the decision makes clear, during

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patent prosecution, when there remains the opportunity to repair claims, the standards are different. *In re Bigio*, 72 USPQ2d 1209, 1211 held that "a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application." Applicants have not done so.

Instead, applicants point to US 4868294. That patent does not have the ambiguous "(OCO)" wording. Applicants the specification does not says that they use definitions taken from that document or any other documents for that matter.

Applicants must therefore repair the claims and explain why one of ordinary skill in the art would have been able to figure out what was correct.

Claims 29-110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase, "less than about 10%" (or other numbers) is inherently unclear. For example, would that language cover 10.1%? That is not clear. Since it is more than 10%, it would seem not. But 10.2% is probably within "about 10%", and 10.1% is less than 10.2%, so perhaps it is covered after all. See *Ex parte Lee*, 31 USPQ 2nd 1105, 1107; *Amgen vs. Chuggai*, 13 USPQ 2nd 1737, 1787; 18 USPQ 2d 1016, 1030. Note that in *Cohesive Technologies Inc. v. Waters Corp.*, 88 USPQ2d 1903, the language "greater than about 30 microns" was held to include 29.01 microns. It is unclear whether applicants actually intend the numbers lower than the indicated figure. Deletion of the "about" is suggested and would resolve the matter.

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Claims 60-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are defective.

A. Claim 60 defines two monovalent moieties, Z-plus with four choices (all bound via N atoms), and Z, with 5 completely different choices (all bound via S atom). As written, all of these are moieties, with the bond of attachment to the left. The first branch of step c) prepares III(i). It reacts Z or HZ with IV to give III(i). The reaction with HZ is not a problem, but the reaction with Z itself does not make sense, because Z is not a compound, it is a moiety, i.e. a piece of a compound. One reacts compounds.

The second branch of step c) prepares III(ii), and there are three problems:

a. III(ii) is defective, because it has an unbalanced charge. Note that this problem does not exist in the final product I(ii), because there is an anion elsewhere (it is a zwitterion).

b. As with the other branch, the reaction with Z itself does not make sense, because Z is not a compound, it is a moiety, i.e. a piece of a compound.

c. But even using HZ will not work, because III(ii) has Z-plus, not Z. A reagent must be employed which has Z-plus, not Z

B. The formulae III(i) and III(ii) use lower case z, but the definitions have upper case Z.

### *Claim Objections*

Claim 110 is objected to as an exact duplicate of claim 46.

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Claim 60 is of improper form. It is an original claim, yet it has what appears to be deletion and insertion language in the first line of step c. A clean copy is needed. Likewise claim 64, and claim 68.

Claim 95 is improperly dependent on claim 94, as it does not further limit; it merely duplicates the claim. Likewise claims 102 and 109.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/  
Primary Examiner  
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